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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/799,826	03/12/2004	Danielle Renee Forget Shield	020976-00100	8615
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LOCKE LORD BISSELL & LIDDELL LLP			RIVIERE, HEIDI M	
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	10/799,826	FORGET SHIELD, DANIELLE RENEE	
Examiner	Art Unit		
Heidi Riviere	3629		

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 12 March 2004.
- 2a) This action is **FINAL**. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 1-23 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) Claim(s) _____ is/are allowed.
- 6) Claim(s) 1-23 is/are rejected.
- 7) Claim(s) _____ is/are objected to.
- 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on 06 August 2004 is/are: a) accepted or b) objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All b) Some * c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) Notice of References Cited (PTO-892)
- 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) Information Disclosure Statement(s) (PTO/SB/08)
 Paper No(s)/Mail Date 12 March 2004.
- 4) Interview Summary (PTO-413)
 Paper No(s)/Mail Date. _____.
- 5) Notice of Informal Patent Application
- 6) Other: _____

DETAILED ACTION

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. **Claims 1, 5-15, 19-23** are rejected under 35 U.S.C. 102(b) as being anticipated by **Mahany et al. (US 5,657,317)** (hereinafter “**Mahany**”).
3. **With respect to claim 1:** Mahany discloses:

a. a waste management electronic base system having a memory, processor, 5 an input element, and an output element, the base system adapted to process waste management data for tracking a location of a waste storage unit, billing a customer associated with a waste removal, and paying personnel for services associated with the waste removal; (col. 46, lines 38-50 – upon reaching destination and at delivery site dock the goods are scanned for delivery verification and as this occurs as this occurs can be generated; Fig. 31; col. 11, line 50-col. 12, line 14; col. 28, lines 14-36; col. 29, lines 55-59; col. 46, lines 38-50 – system consists of scanner, portable key board as well as wireless system; col. 62, lines 4-18 and 45-59 - terminal in the truck automatically relays “preliminary invoice” to the base station; upon delivery, verified invoice is automatically routed to inventory computer) and

b. an electronic portable unit having a memory, processor, an input element, and an output element, the portable unit adapted to allow an operator during a waste removal to use the portable unit and to allow onsite input at a customer facility from preprogrammed queries regarding the waste removal and further being adapted to generate an output of the data to the base system for processing. (Fig. 31; col. 11, line 50-col. 12, line 14; col. 28, lines 14-36; col. 29, lines 55-59 – “portable/mobile device 1413 is initially registered with base station 1401, which acts as control point for the portable/mobile device 1413”; system consists of scanner, portable key board as well as wireless system).

4. **With respect to claims 5 and 20:** Mahany discloses the onsite input allows operator input, automatic input, or a combination thereof. (col. 46, lines 38-50 – upon reaching destination and at delivery site dock the goods are scanned for delivery verification and as this occurs as this occurs can be generated).

5. **With respect to claims 6 and 21:** Mahany discloses the onsite input comprises a scanner, keyboard, touch screen, wireless interface, voice recognition interpreter, preprogrammed cards, or a combination thereof. (Fig. 31; col. 11, line 50-col. 12, line 14; col. 28, lines 14-36; col. 29, lines 55-59; col. 46, lines 38-50 – system consists of scanner, portable key board as well as wireless system).

6. **With respect to claim 7:** Mahany discloses the portable unit output comprises a wireless interface with the base system. (col. 11, line 50-col. 12, line 14; col. 28, lines 14-36; col. 29, lines 55-59 – “portable/mobile device 1413 is initially registered with base station 1401, which acts as control point for the portable/mobile device 1413”).

7. **With respect to claim 8:** Mahany discloses the system further comprises multiple portable units for multiple operators during their respective routes for multiple waste removals. (col. 11, line 50-col. 12, line 14; col. 28, lines 14-36; col. 29, lines 55-59 – “base stations 56, 58 and 59 can support multiple mobile computing devices”; “portable/mobile device 1413 is initially registered with base station 1401, which acts as control point for the portable/mobile device 1413”).

8. **With respect to claims 9 and 13:** Mahany discloses the base system is adapted to provide download information to the portable unit, the information containing instructions to the operator for a route of the operator. (col. 46, lines 51-67 - “the truck 3033 leaves the dock in the morning with the addresses and directions of the service destinations, technical manuals, and service notes which have been selectively downloaded from the host computer 3011 via either the premises or peripheral Lan to the storage terminal 3031”).

9. **With respect to claims 10, 14 and 23:** Mahany discloses the portable unit is adapted to require predetermined operator input for a first operation to release the operator to perform a next operation. (col. 62, lines 4-18 and 45-59 - terminal in the truck automatically relays “preliminary invoice” to the base station; upon delivery, verified invoice is automatically routed to inventory computer).

10. **With respect to claims 11 and 19:** Mahany discloses the portable unit is adapted to output an invoice for a customer at the customer site relative to the waste removal. (col. 62, lines 4-18 and 45-59 - terminal in the truck automatically relays

"preliminary invoice" to the base station; upon delivery, verified invoice is automatically routed to inventory computer).

11. With respect to claim 12: Mahany discloses: a. using a waste management electronic base system having a memory, processor, an input element, and an output element, to process waste management data, comprising:

- i. tracking a location of a waste storage unit;
- ii. billing a customer associated with a waste removal; and
- iii. paying personnel for services associated with the waste removal;

(col. 46, lines 38-50 – upon reaching destination and at delivery site dock the goods are scanned for delivery verification and as this occurs as this occurs can be generated; Fig. 31; col. 11, line 50-col. 12, line 14; col. 28, lines 14-36; col. 29, lines 55-59; col. 46, lines 38-50 – system consists of scanner, portable key board as well as wireless system; col. 62, lines 4-18 and 45-59 - terminal in the truck automatically relays "preliminary invoice" to the base station; upon delivery, verified invoice is automatically routed to inventory computer) and

b. using an electronic portable unit having a memory, processor, an input element, and an output element, to gather onsite data for the base system, comprising:

- i. allowing an operator to input onsite data at a customer facility into the portable unit from preprogrammed queries regarding the waste removal; and
- ii. generating an output of the data to the base system for processing.

(col. 46, lines 38-50 – upon reaching destination and at delivery site dock the goods are scanned for delivery verification and as this occurs as this occurs can be generated; Fig. 31; col. 11, line 50-col. 12, line 14; col. 28, lines 14-36; col. 29, lines 55-59; col. 46, lines 38-50 – system consists of scanner, portable key board as well as wireless system; col. 62, lines 4-18 and 45-59 - terminal in the truck automatically relays "preliminary invoice" to the base station; upon delivery, verified invoice is automatically routed to inventory computer).

12. **With respect to claim 15:** Mahany discloses scanning input information into the portable unit regarding a waste storage unit. (col. 46, lines 38-50 – upon reaching destination and at delivery site dock the goods are scanned for delivery verification and as this occurs as this occurs can be generated).

13. **With respect to claim 22:** Mahany discloses sharing information between the portable unit and the base system through a wireless interface. (col. 11, line 50-col. 12, line 14; col. 28, lines 14-36; col. 29, lines 55-59 – "base stations 56, 58 and 59 can support multiple mobile computing devices"; "portable/mobile device 1413 is initially registered with base station 1401, which acts as control point for the portable/mobile device 1413"; system allows for wireless communication).

Claim Rejections - 35 USC § 103

14. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

15. **Claims 2 and 16** are rejected under 35 U.S.C. 103(a) as being unpatentable over **Mahany** in view of **Hassett (US 5,347,274)**.

16. **With respect to claims 2 and 16:** Mahany teaches the limitations in the rejections above. However, Mahany does not teach a waste removal vehicle and a waste storage unit selectively coupled with the waste removal vehicle. Hassett teaches a waste removal vehicle and a waste storage unit selectively coupled with the waste removal vehicle. (col. 3, lines 52-62 – “the invention contemplates embodiments adapted to all modes of transport... the term “vehicle” as used in the disclosure and the patent claims herein is to include boat, airplane, truck, rail car or engine, and all other forms of transport vehicle, as well as such tanks, containers or vessels as may demountably attach to or be carried by a transport vehicle”).

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to combine the portable wireless system of Mahany with the waste removal and storage unit in Hassett because of the need to “generate or update reports, or warnings, as appropriate” (Hassett: col. 4, lines 43-47).

17. **Claims 3, 4, 17 and 18** are rejected under 35 U.S.C. 103(a) as being unpatentable over **Mahany** in view of **Tsukamoto (US 2003/0014334 A1)**.

18. **With respect to claims 3 and 17:** Mahany teaches the limitations in the rejections above. However, Mahany does not teach the waste comprises industrial

waste and the system is adapted to comply with a manifest associated with the industrial waste. Tsukamoto teaches the waste comprises industrial waste and the system is adapted to comply with a manifest associated with the industrial waste. (paragraph 23 – “items transferred as said manifest data 6 are data such as the type, quantity, weight, shape, type of packing, and the results of component analysis of the waste 1 and the locations, names and people in charge of the discharging company 8, the collection/transportation company 9, and the company 10 dealing with intermediate-treatment/final-disposal. In this mode, it is preferable that the manifest data 6 many be transferred to the data management unit 5 by the record-transfer means 4 with the signatures of people in charge by using personal digital assistants. Portable telephones capable of transferring text data, electronic notebooks having communication functions”)

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to combine to portable wireless system of Mahany with the electronic manifest of Tsukamoto because of the need for all parties to have access to data via access means such as the Internet. (Tsukamoto: paragraph 20).

Furthermore, the data identifying type of waste is non-functional descriptive data.

Descriptive material can be characterized as either "functional descriptive material" or "nonfunctional descriptive material." Exemplary "functional descriptive material" consists of data structures and computer programs, which impart functionality when employed as a computer component. "Nonfunctional descriptive material" includes but is not limited to music, literary works and a compilation or mere arrangement of data.

When presented with a claim comprising descriptive material, an Examiner must determine whether the claimed nonfunctional descriptive material should be given patentable weight. The Patent and Trademark Office (PTO) must consider all claim limitations when determining patentability of an invention over the prior art. *In re Gulack*, 703 F.2d 1381, 1385, 217 USPQ 401,404 (Fed. Cir. 1983). The PTO may not disregard claim limitations comprised of printed matter. See *Gulack*, 703 F.2d at 1384-85,217 USPQ at 403; see also *Diamond v. Diehr*, 450 U.S. 175, 191,209 USPQ 1, 10 (1981). However, the examiner need not give patentable weight to descriptive material absent a new and unobvious functional relationship between the descriptive material and the subset. See *In re Lowry*, 32 F.3d 1579, 1583-84, 32 USPQ2d 1031, 1035 (Fed. Cir. 1994); *In re Ngai*, 367 F.3d 1336, 1338, 70 USPQ2d 1862, 1863-64 (Fed. Cir. 2004). Thus, when the prior art describes all the claimed structural and functional relationships between the descriptive material and the subset, but the prior art describes a different descriptive material than the claim, then the descriptive material is nonfunctional and will not be given any patentable weight. That is, such a scenario presents no new and unobvious functional relationship between the descriptive material and the subset.

The Examiner asserts that the data identifying type of waste adds little, if anything, to the claimed acts or steps and thus do no serve as limitations on the claims to distinguish over the prior art. MPEP 2106IV b 1(b) indicates that "nonfunctional descriptive material" is material "that cannot exhibit any functional interrelationship with the way the steps are performed". Any differences related merely to the meaning and information conveyed through data, which does not explicitly alter or impact the steps is

non-functional descriptive data. The subjective interpretation of the data does not patentably distinguish the claimed invention.

19. **With respect to claim 4:** Mahany teaches the limitations in the rejections above. However, Mahany does not teach the base system generates a manifest based on information from a generator of waste obtained from the portable unit. Tsukamoto teaches the base system generates a manifest based on information from a generator of waste obtained from the portable unit. (paragraph 23 – "items transferred as said manifest data 6 are data such as the type, quantity, weight, shape, type of packing, and the results of component analysis of the waste 1 and the locations, names and people in charge of the discharging company 8, the collection/transportation company 9, and the company 10 dealing with intermediate-treatment/final-disposal. In this mode, it is preferable that the manifest data 6 many be transferred to the data management unit 5 by the record-transfer means 4 with the signatures of people in charge by using personal digital assistants. Portable telephones capable of transferring text data, electronic notebooks having communication functions").

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to combine the portable wireless system of Mahany with the electronic manifest of Tsukamoto because of the need for all parties to have access to data via access means such as the Internet. (Tsukamoto: paragraph 20).

20. **With respect to claim 18:** Mahany teaches the limitations in the rejections above. However, Mahany does not teach accepting an electronic manifest into the

portable unit. Tsukamoto teaches accepting an electronic manifest into the portable unit. (paragraph 23 – “items transferred as said manifest data 6 are data such as the type, quantity, weight, shape, type of packing, and the results of component analysis of the waste 1 and the locations, names and people in charge of the discharging company 8, the collection/transportation company 9, and the company 10 dealing with intermediate-treatment/final-disposal. In this mode, it is preferable that the manifest data 6 many be transferred to the data management unit 5 by the record-transfer means 4 with the signatures of people in charge by using personal digital assistants. Portable telephones capable of transferring text data, electronic notebooks having communication functions”).

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to combine the portable wireless system of Mahany with the electronic manifest of Tsukamoto because of the need for all parties to have access to data via access means such as the Internet. (Tsukamoto: paragraph 20).

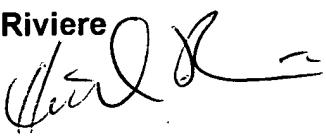
CONCLUSION

21. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Heidi Riviere whose telephone number is 571-270-1831. The examiner can normally be reached on Monday-Friday 9:00am-5:00pm EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Weiss can be reached on 571-272-6812. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

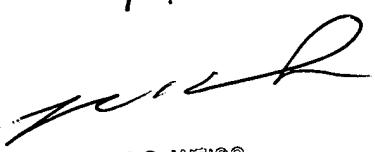
Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Name: Heidi Riviere

Signature: 

Title: Examiner

Date: 1/5/08


JOHN S. WEISS
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